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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,162	07/25/2003	Stephan Kirchmeyer	CH-7855/STA-211	2513
23416 7590 03/09/2009 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
EXAMINER				
NERANGIS, VICKIE MARIE				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
03/09/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/627,162

**Applicant(s)**

KIRCHMEYER ET AL.

**Examiner**

Vickey Nerangis

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-24, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-24, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
2. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 1/21/2009. In particular, claim s 27 and 28 are new. Thus, the following action is properly made final.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 27 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, an oxidizing agent comprising iron, cobalt, nickel, molybdenum or vanadium fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of a non-ion iron, cobalt, nickel, molybdenum or vanadium oxidizing agent in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. While there is support for an oxidizing agent that includes ions such as cobalt, nickel, molybdenum, and vanadium ions

on page 7, lines 26-28 of the specification, there is no support for non-ionic iron, cobalt, nickel, molybdenum or vanadium oxidizing agents.

***Claim Rejections - 35 USC § 103***

4. Claims 7-24, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas et al (US 5,300,575) in view of Mochwald (US 4,728,399).

With respect to claims 7-24, they rejection is adequately set forth in paragraph 3 of Office action mailed on 3/21/2008 and is incorporated here by reference.

With respect to claims 27 and 28, Jonas teaches the use of catalytically effective amounts of iron, cobalt, nickel, molybdenum, and vanadium ions are used as oxidizing agents (col. 3, lines 58-62). Jonas teaches that the oxidizing agent is used in an amount of 0.1-2 equivalents per mol thiophene (col. 4, lines 15-21).

***Double Patenting***

5. Applicant's statement on page 7 of the response filed on 1/21/2009 about filing a terminal disclaimer upon reassignment of copending Application No. 11/178,852 for the following obviousness-type double patenting rejection is acknowledged. Upon filing of the terminal disclaimer, the obviousness-type double patenting rejection is maintained below.

6. Claims 7-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3-5 of copending Application No. 11/178,852 (published as US 2006/0020092).

The rejection is adequately set forth in paragraph 4 of Office action mailed on 9/19/2008 and is incorporated here by reference.

***Response to Arguments***

7. Applicant's arguments filed 1/21/2009 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that the examiner has relied upon improper hindsight reconstruction to reject the instant claims; (B) that it would not have been obvious to one of ordinary skill in the art to lower the pH because a fast reaction results in different end products and (C) that by amending the polyanion to be a polystyrene sulfonic acid, the data is reasonably commensurate in scope with the scope of the claims.

With respect to argument (A), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner has relied upon the references and the teachings and motivations contained within to arrive at the presently claimed invention.

With respect to argument (B), it has not been shown why different end products having different particle sizes and molar weights would affect the physical properties of the polymer. Specifically, it is not made clear how these differences would preclude the polymer from being conductive and transparent.

With respect to argument (C), while the the type of polyanion commensurate in scope with the scope of the claims, it is insufficient to overcome all concerns. Mainly, the examples are not proper side-by-side examples. Specifically, Examples 13 and 15-18 and Comparative Example 3 are not proper side-by-side examples because there is less peroxodisulfuric acid oxidizing agent in Examples 13 and 15-18 (even when converted to molar amounts) than the sodium peroxodisulfate oxidizing agent in Comparative Example 3. Therefore, applicant has not established that a low pH like presently claimed results in improved transparency and conductivity.

### *Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Nerangis whose telephone number is (571) 272-2701.

The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/9/2009  
vn

/Vickey Nerangis/  
Examiner, Art Unit 1796